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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,323	01/31/2002	Carl W. Gilbert	329.1001-U	9839
20311	7590	08/17/2005	EXAMINER	
MUSERLIAN, LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/066,323

Applicant(s)

GILBERT ET AL.

Examiner

Taylor Victor Oh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see pages 2-6. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

It is noted that applicants have filed an Amendment after the Final Rejection on 7/7/05; applicants' attorney has addressed the issues of record. The proposed amendment will not be entered because it raises a new issue that would require further consideration and search ; and , it is not in a condition for allowance.

The Status of Claims:

Claims 1-12, 14, 16, 22, 24-25, and 31 are pending.

Claims 1-12, 14, 16, 22, 24-25, and 31 have been rejected.

Claim Objections

The objection of claims 5 and 24 has been maintained due to the failure to modify the claims.

Claim Rejections-35 USC 112

I. Applicants' argument filed 7/7/05 have been fully considered but they are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 5-6 , 9 , and 24 under 35 U.S.C. 112, second paragraph can be overcome with the proposed modification in the amendment, whereas the rejection of Claims 1-12, 14, 16, 22, 24-25, and 31 under 35 U.S.C. 112, second paragraph has been maintained because there are still some issues in claims 1 and 31 in the proposed amendment ; for example, in claim 1 , the phrase "L is a linker for linking NHR₂₂ to B " is recited. The specification does not elaborate what the linker is for linking NHR₂₂ to B. Furthermore, the term " a linker " is not defined in the compound claim.

Regarding claim 31, the phrase " L₁ is a moiety containing a functional group capable of reacting with the NHR₂₂" is recited. The expression is vague and indefinite because L₁ is clearly not defined in the compound formula; L₁ needs to have a structural chemical formula in the compound claim. Furthermore, in claim 31, the phrases "polymer" and "polymeric supports" are recited. The expression is vague and indefinite because the specification does not elaborate on what is meant by the phrases "polymer" and "polymeric supports". Therefore, an appropriate correction is required.

The new issue

The phrase "a linker for linking NR₂₂ to B " in claim1 raises a new issue that would require further consideration and search.

Applicants' Argument

Applicants argue the following issues:

- a. The Examiner has not made a proper prima facie case of indefiniteness; applicants have defined certain portions of the claimed compound as a "first and a "second " moiety in order to distinguish them ; furthermore, the specification has described the A and B moieties ; therefore, they are definite ;
- b. The USPTO has repeatedly accepted the term " linker " as appropriate in claim language since commonly-assigned US 6,774,116 has the same and similar descriptions used for the terms A, B, polymer, active moiety ; furthermore, US patent Nos 6,914,121, 6,913,748, 6,908,942, and 6,906,076 and other examples can be given the similar descriptions used for the term " linker " in the claims.
- c. The terms "electron donating or withdrawing groups" are well-known to those of ordinary skill; therefore, applicants are not required to give an exhaustive list of such groups.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first argument, the Examiner has noted applicants' arguments. However, the terms such as the "first " and the "second " moiety are used in the compound claims without specifying each of the chemical moieties; this is indefinite because there is no way of telling which one is the first or the second moiety; in order to identify the clear boundaries of the compounds, each substituent attached to the core of the compounds needs to be specific. Otherwise, the current inventors may claim the future the "first " and the "second " moiety ,which have not

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been discovered yet. Because of this, it is also a Reach –Through Claim. Therefore, in order to overcome the rejection, the examiner recommends to add each of the specific “first “ and the “second ” chemical moieties to the claims.

Second, regarding the second argument, the Examiner has noted applicants' arguments. However, with respect to those patents examined by other examiners, which I can not make any remark on. But I can say that the examiner did it before the policy of Tech center has been changed. If the term “ a linker “ were clearly defined in the specification, then the examiner would have no problem in that term. However, the specification has disclosed that non-limiting list of linkers include succinimides ,maleimides, imidoesters, 2-iminothiolane, hydrazides, maleic anhydride, azides , citraconic anhydride, glutaraldehyde, and etc. This description implies that any linkers unrelated to one another may work for the claimed compounds; in other words, it fails to point out what is included or excluded by the claim language. This type of the claim is directed to an omnibus type claim. Therefore, the issues of the claims are still remained.

Third, regarding the third argument, the Examiner has agreed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Taylor Oh
8/10/05

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